

Application No.: 10/787,443
Amendment dated August 1, 2008
Reply to Office Action dated Feb. 1, 2008

REMARKS

Claims 1-49 were pending in the present application at the time of the Office Action.

Claims 1-49 stand rejected under U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,084,867 to Meier (“*Meier*”).

Claims 32-49 have been canceled by the present amendment.

For at least the reasons stated below, the Applicants respectfully traverse the above rejections.

Amendment to the Specification

The specification has been amended to more clearly state the relationship between related applications and the presently pending claims. The Applicants submit that no new matter has been added.

Rejections Under 35 U.S.C. § 102(e)

Turning first to the rejection of claims 1-8, 10-11, 13-15 and 18-24 under 35 U.S.C. § 102(e) as being anticipated by *Meier*, the Applicants respectfully traverse such rejections.

MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1, as currently amended is directed to a system in a communication network, where the system comprises a mobile computing device that comprises particular elements. Independent claim 11 is directed to a mobile computing device. Independent claims 18 is directed to at least one communication module for use in a mobile computing device. Independent claim 25 is directed to a communication module for use in a mobile computing device.

The Office Action, cites to various communication system characteristics shown by *Meier*, and then, at page 4, states “The recitation that ‘a portable data collection terminal’ has not

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been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)."

The Applicants respectfully disagree with this position adopted by the Examiner. For example, the Examiner is apparently quoting a section of the MPEP (*i.e.*, § 2111.02(II)) regarding statements reciting purpose or intended use. The Applicants respectfully submit that the Examiner's reliance on MPEP § 2111.02(II) is inappropriate in this instance. The Applicants refer the Examiner to MPEP § 2111.02(I), which states "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation".

Turning first to claims 1-10, the Applicants submit that claim 1 is directed to a system comprising "a mobile computing device" where such mobile computing device, in turn, comprises particular elements. The Applicants disagree that the phrase "mobile computing device" needs to be stated in the body of the claim, as opposed to the preamble, to have meaning. Nonetheless, to advance prosecution of the present application, claim 1, and thus claims 2-10, have been amended to place the phrase "mobile computing device" in the body of the claim. The Applicants submit that the phrase "a mobile computing device" in claims 1-10 must be given patentable weight.

In addressing claims 1-10, the Office Action refers to many aspects of the *Meier* system that are not elements of a mobile computing device. Accordingly, the Applicants respectfully submit that the Office Action has not stated an anticipation rejection of claims 1-10 that meets the mandates of MPEP § 2131, and that claims 1-10 are allowable over *Meier*.

Turning next to claims 11-17, the Applicants submit that claim 11 is clearly directed to "a mobile computing device". For example, the preamble only states "A mobile computing device comprising:". The statement "A mobile computing device comprising:" clearly limits the structure of the claimed invention by stating the requirement that all of the elements enumerated in the body are elements of the claimed mobile computing device. Thus, in accordance with the mandates of MPEP § 2111.02(I), the Applicants submit that the phrase "a mobile computing device" in claims 11-17 must be given patentable weight.

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In addressing claims 11-17, the Office Action refers to many aspects of the *Meier* system that are not elements of a mobile computing device. Accordingly, the Applicants respectfully submit that the Office Action has not stated an anticipation rejection of claims 11-17 that meets the mandates of MPEP § 2131, and that claims 11-17 are allowable over *Meier*.

Turning next to claims 18-24, the Applicants submit that claim 18, as currently amended, is directed to “at least one communication module for use in a mobile computing device”. Though the phrase “for use in a mobile computing device” is arguably a “statement reciting purpose or intended use”, the phrase clearly limits the structure of the claimed invention by stating the requirement that the “at least one communication module”, the elements of which are described in the body of the claim, is for use *in a mobile computing device*. As a non-limiting example, consider a scenario where a plurality of communication modules simply cannot fit in a mobile computing device or would otherwise be ineffective in a mobile computing device. Such communication modules would be excluded by the structural limitation provided by the phrase “for use in a mobile computing device”. Thus, in accordance with the mandates of MPEP § 2111.02(I), the Applicants submit that the phrase “for use in a mobile computing device” in claims 18-24 must be given patentable weight.

In addressing claims 18-24, the Office Action refers to many aspects of the *Meier* system that are not elements for use in a mobile computing device. Accordingly, the Applicants respectfully submit that the Office Action has not stated an anticipation rejection of claims 18-24 that meets the mandates of MPEP § 2131, and that claims 18-24 are allowable over *Meier*.

Turning next to claims 25-31, the Applicants submit that claim 25, as currently amended, is directed to “a communication module for use in a mobile computing device”. Though the phrase “for use in a mobile computing device” is arguably a “statement reciting purpose or intended use”, the phrase clearly limits the structure of the claimed invention by stating the requirement that the “communication module”, the elements of which are described in the body of the claim, is for use *in a mobile computing device*. As a non-limiting example, consider a scenario where a communication module simply cannot fit in a mobile computing device. Such a communication module would be excluded by the structural limitation provided by the phrase “for use in a mobile computing device”. Thus, in accordance with the mandates of MPEP §

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2111.02(I), the Applicants submit that the phrase “for use in a mobile computing device” in claims 25-31 must be given patentable weight.

In addressing claims 25-31, the Office Action refers to many aspects of the *Meier* system that are not elements of “a communication module”, much less elements of “a communication module for use in a mobile computing device”. Accordingly, the Applicants respectfully submit that the Office Action has not stated an anticipation rejection of claims 25-31 that meets the mandates of MPEP § 2131, and that claims 25-31 are allowable over *Meier*.

Claims 32-49 have been canceled by the present amendment, without prejudice, to narrow the focus of the present examination. The Applicants reserve the right to resubmit such claims in the future (*e.g.*, in a continuation or divisional application).

Final Matters

The Office Action makes various statements regarding the pending claims, *Meier*, respective priority dates of *Meier* and the present application, and 35 U.S.C. § 102 that are now moot in view of the previous amendments and/or arguments. Accordingly, the Applicants will not address all of such statements at the present time. The Applicants expressly reserve the right to challenge any or all of such statements in the future should the need arise (*e.g.*, if such statements should become relevant by appearing in a future rejection of any claim).

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Summary

Based on at least the foregoing, the Applicants believe that claims 1-31 are in condition for allowance. Accordingly, the Applicants courteously solicit a Notice of Allowability with respect to all pending claims. If the Examiner disagrees or has any question regarding this submission, the Applicants respectfully request that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge any other fees required by this submission or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: August 1, 2008

Respectfully submitted,

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